

JC860 U.S. PTO

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PATENT
ATTORNEY DOCKET NO.: 046124-5005-02-US



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**Assistant Commissioner for Patents
BOX PATENT APPLICATION
Washington, D.C. 20231**

PRIOR APPLICATION: Examiner: E. Slobodyansky, Ph.D.
Group Art Unit: 1652

DIVISIONAL PATENT APPLICATION TRANSMITTAL
UNDER 37 C.F.R. § 1.53(b)

This is a request for filing a patent application under 37 C.F.R. § 1.53(b).

1. This application is a Divisional patent application under 37 C.F.R. § 1.53(b), of pending prior application no. 09/615,655, filed on July 13, 2000, of:

Inventors: Takashi OSUMI; Toshiro TSUKAMOTO; Noriyo TSUKAMOTO; and Masatoshi YAMASAKI.

For: GREEN FLUORESCENT PROTEINS AND BLUE FLUORESCENT PROTEINS

2. The papers enclosed are as follows:

45 Page(s) of specification including:

0 Title Page

2 Page(s) of claims

1 Page of abstract

7 Sheet(s) of drawings containing 7 Figures

- ### 3. Amendments

For continuation and divisional applications:

- Cancel in this application original claims 1-7 in the enclosed copy of prior application before calculating the filing fee.

A preliminary amendment is enclosed.

4. Oath or Declaration

For continuation or divisional applications:

- A copy of an oath or declaration from a prior application is enclosed under 37 C.F.R. § 1.63(d). The entire disclosure of the prior application, from which a copy of the oath or declaration is supplied is considered as part of the disclosure of the accompanying application and is hereby incorporated by reference therein.

For continuation-in-part applications:

- A newly executed (original or copy) oath or declaration is enclosed.
- An oath or declaration is not enclosed. This application is being filed under 37 C.F.R. § 1.53(f). Applicant(s) await notification from the Patent and Trademark Office of the time set for filing the declaration and paying the filing fees.

5. Relate Back - 35 U.S.C. § 120

- Amend the specification by inserting before the first line the sentence:

A!
~This application is a divisional of copending U.S. patent application Serial No. 09/615,655 filed July 13, 2000, which is a continuation of application Serial No. 9/121,539, filed July 24, 1998, now U.S. Patent 6,194,548, which claims priority to Japanese Patent Application No. 10-26418, filed January 23, 1998. The disclosures of each of the foregoing applications are incorporated herein by reference.~

6. Priority - foreign applications under 35 U.S.C. § 119(a)-(d) or § 365(b) or PCT international applications under 35 U.S.C. § 365(a) designating at least one country other than the U.S.

- Priority of the following foreign application is claimed:

| Country | Application No. | Filed |
|---------|-----------------|-----------------|
| Japan | 026418/1998 | 23 January 1998 |

A certified copy was filed in the parent U.S. Application No. 09/121,539 on October 28, 1998 and a certified translation thereof was filed on November 30, 1999. For the convenience of the Examiner, a copy of the certified translation as filed in the parent application is filed herewith.

7. Assignment

For continuation or divisional applications:

- The prior application is assigned of record to Takashi Osumi, recorded on October 20, 1998 at Reel/Frame 9522/0170. A copy of the Notice of Recordation of Assignment Document is enclosed.
- An assignment of the invention to _____ and a PTO Form-1595, Recordation Form Cover Sheet, are enclosed.

For continuation-in-part applications:

- An assignment of the invention to _____ and a PTO Form-1595, Recordation Form Cover Sheet, are enclosed.

8. Fee Calculation (37 C.F.R. § 1.16)

| CLAIMS FOR FEE CALCULATION | | | | |
|---|--------------|--------------|---|------------|
| | Number Filed | Number Extra | at Rate of | Basic Fee |
| Total Claims (37 C.F.R. § 1.16(c)) | 27 - 20 = | 7 | \$ 18.00 each = | + \$126.00 |
| Independent Claims (37 C.F.R. § 1.16(b)) | 9 - 3 = | 6 | \$ 80.00 each = | + \$480.00 |
| Multiple dependent claim(s), if any (37 C.F.R. § 1.16(d)) | | | \$270.00 | + \$270.00 |
| | | | SUB-TOTAL = | \$1,586.00 |
| | | | Reduction by ½ for filing by a small entity | - \$ |
| | | | TOTAL FILING FEE = | \$1,586.00 |

9. Fee Payment

- Not Enclosed. **NO FEE IS BEING PAID BY CHECK OR DEPOSIT ACCOUNT AT THIS TIME.** This application is being filed under the provisions of 37 C.F.R. § 1.53(f). Applicant(s) await notification from the Patent and Trademark Office of the time set for filing the Declaration and paying the filing fees.
- Enclosed.

A check in the amount of **\$1,586.00** to cover the filing fee (\$710.0), the additional dependent claims fee (\$126.00) the additional independent claims fee (\$480.00) and the multiple dependent claims fee (\$270.00) is enclosed.

- The fee for extra claims under 37 C.F.R. § 1.16(d) is not being paid at this time and no authorization is given to charge our deposit account for this fee.
- The Commissioner is hereby authorized to charge \$____ to Deposit Account 50-0310 for payment of the filing fee. The Commissioner is also hereby authorized to charge any additional fees which may be required, including fees due under 37 CFR §§ 1.16 and 1.17, or credit any overpayment to Deposit Account 50-0310.

10. Small Entity Status is claimed and

- a statement claiming small entity status is enclosed, or
- a small entity statement was filed in the prior nonprovisional application and is still proper and desired.

11. The power of attorney in the prior application is to at least one of the registered practitioners of Morgan, Lewis & Bockius LLP included in the Customer Number provided below to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith, and all correspondence shall be addressed to that Customer Number.

Please address all correspondence to Morgan, Lewis & Bockius LLP at
Customer Number: 009629

12. Recognize as associate attorney _____
(name, address, and registration no.)

13. **PETITION FOR EXTENSION OF TIME.** If any extension of time is necessary for the filing of this application, including any extension in the prior application, application no. 09/651,655, filed July 13, 2000, for the purpose of maintaining copendency between the prior application and the present application, and such extension has not otherwise been requested, such an extension is hereby requested, and the Commissioner is authorized to charge necessary fees for such an extension to Deposit Account No. 50-0310.
14. **EXCEPT** for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 50-0310. This paragraph is intended to be an **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).
15. Additional papers enclosed:
- Information Disclosure Statement
 Form PTO-1449
 Declaration of Biological Deposit
 Submission of "Sequence Listing", computer readable copy and/or amendment pertaining thereto for biotechnology invention containing nucleotide and/or amino acid sequence.

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP


By: _____
Thomas F. Poché
Reg. No. 45,017

Dated: May 10, 2001

Customer No. 09629
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